06-18-03

1614

CASE OP/4-31902A/USN

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV335541588US — Express Mail Label Number

June 17, 2003 — Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

LAMBROU ET AL.

APPLICATION NO: 10/090,085

FILED: MARCH 4, 2002

FOR: METHOD FOR OPENING POTASSIUM CHANNELS

Art Unit: 1614

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Office Action mailed May 20, 2003.

The Examiner has indicated that the claimed subject matter is drawn to three distinct inventions and has required restriction to one of the following inventions, Group I: Claims 1-2, 5-6 and 9-10 drawn to a method of opening potassium channels in the cell membranes of a mammal, Group II: Claims 3, 7 and 11 drawn to a method of maintaining or inducing hyperpolarization in the cell membranes of a mammal and Group III: Claims 4, 8 and 12 drawn to a method for treating conditions and disease states characterized by excessive cell membrane depolarization. Applicants provisionally elect, with traverse, to prosecute the invention of Group I: Claims 1-2, 5-6 and 9-10.

35 U.S.C.§ 121 maintains that for a proper requirement for restriction, the dual criteria of the statute must be met, that is, the application must contain two or more inventions which are both (1) "independent" and (2) "distinct" from one another. According to the U.S. Patent and Trademark Office's own definition, "independent" means "there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect..."(Section 802.01 of the Manual of Patent Examining Procedure). The specification of the present application discloses a relationship and connection between the Claims of Group I and Groups II and III. In particular, the method set forth in the Group 2 Claims requires a subgenus of a compound that is recited in the method of Group I Claims. In addition, the method recited in the Claims of Group III requires the same compound as is recited in method of

the Group I Claims. Accordingly, the Claims of Group I are related and connected to the Claims of Groups II and III. Accordingly, the requirement for restriction and election is unwarranted under 35 U.S.C. §121 which, in order to authorize restriction, requires that the application claim "two or more independent and distinct inventions".

As a second ground for traversal, Applicants submit that the Examiner has failed to show that there would be a "serious burden" upon the Patent and Trademark Office to examine all of the pending claims. In this regard, MPEP §803, second paragraph, states:

"There must be a serious burden on the examiner if restriction is required."

It is respectfully submitted that since the Claims in Groups I, II and III either require the same compound or subgenus of the same compound, that a search and examination of Groups II and III would substantially overlap with a search and examination of Group I and therefore would not impose a "serious burden" on the Examiner. In view of the above, withdrawal of the Restriction Requirement is respectfully requested. Applicants retain the right to petition from the Restriction Requirement under 37 C.F.R.§1.144.

Early and favorable action are respectfully requested.

Respectfully submitted,

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Date: June 17, 2003